

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 14, 2004. At the time of the Office Action, Claims 1, 4-17, 19-30, 32-41, 43-46, and 48-57 were pending in this Application. Claims 1, 4-17, 19-30, 32-41, 43-46, and 48-57 were rejected. Claims 1, 5-14, 16, 17, 19, 20, 21, 27, 30, and 46 have been amended to further define various features of Applicants invention. Claims 2, 3, 18, 31, 42, and 47 were previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

#### **Claim Objections under 37 C.F.R. 1.75(c)**

Claims 5-14 and 19-21 were objected to by the Examiner as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants have amended Claims 5-14 and 19-21 and submit such amendments overcome the rejection. Claims 5-14 further specify the “services” claimed in Claim 1 and Claims 19-21 further specify the equipment information input by a purchaser.

#### **Rejections under 35 U.S.C. § 112**

Claims 6-9 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 6-9 to overcome these rejections and respectfully request full allowance of Claims 6-9 as amended.

#### **Rejections under 35 U.S.C. §103**

Claims 1, 4-17, 19-30, 32-41, 43-46, and 48-57 were rejected by the Examiner under 35 U.S.C. 103(a) as being obvious over non-patent document Wallys W. Conhaim’s “Thomas Publishing” dated Jul/Aug 1998 (“Conhaim”) in view of non-patent document “*Thomasregister.com*” from website of <http://www.thomasregister.com>, archived 16 November 1999 at <http://www.waybackmachine.org> (“Thomasregister.com”). Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580

(C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, a *prima facie* case of obviousness has not been established. The presently claimed embodiments of the invention include the following claim language in the independent claims:

Claim 1.

“displaying over the network in conjunction with the on-line marketplace an identification of relocation and acquisition services relating to the purchase of industrial equipment”

and

“accepting over the network input from the purchaser identifying relocation and/or acquisition services relating to industrial equipment purchase as to which the purchaser wishes to receive information ...”

Claim 27.

“providing information to an on-line marketplace for industrial equipment relating to services for industrial equipment or use and information regarding industrial equipment for which services are sought”

and

“transmitting to the on-line service provider information responsive to the purchaser’s request, the information transmitted in conjunction with the purchaser identification code.”

Claim 30.

“including in the purchaser service request record a service indicator for each service selected by the purchaser [of industrial equipment], the service indicator being a function of the identity of each respective selected service ...”

Claim 36.

“providing an identification of a service relating to the industrial equipment ...

“transmitting information to the [service] provider of the at least one service relating to the request for an estimate and information relating to the code assigned to the user ...”

Claim 40.

“means displaying over the network in conjunction with the on-line marketplace an identification of a plurality of services relating to the acquisition of industrial equipment ...”

Claim 43.

“means for transmitting to an on-line service provider information responsive to the purchaser’s request, the information transmitted in conjunction with the purchaser [of industrial equipment] identification code.”

Claim 46.

“means for including in the purchaser [of industrial equipment] service request record a service indicator for each service selected by the purchaser [of industrial equipment], the service

indicator being a function of the identity of each respective selected service ...”

Claim 52.

“means for providing an identification of a service relating to the industrial equipment;”

and

“means for transmitting information to the [service] provider of the at least one service relating to the request for an estimate and information relating to the code assigned to the user ...”

Claim 56.

“Accepting, from the purchaser [of industrial equipment] information concerning industrial equipment for which at least one selected service is sought ...”

Claim 57.

“means for accepting, from the purchaser [of industrial equipment], input identifying selection of at least one of a plurality of services regarding which the purchaser wishes to receive information and information concerning industrial equipment for which the at least one selected service is sought ...”

(emphasis added).

Each of the above-identified independent claims includes language, as emphasized, relating to the provision of services relating to the purchase of industrial equipment, *e.g.*, financial services, transport services, shipping services, etc.

An object of the claimed embodiment, as detailed in the present application specification, is the provision of a system and/or method whereby a purchaser of a piece of industrial equipment is given access to services relating to the purchase of the equipment, *e.g.*, relating to the relocation of the industrial equipment in connection with a purchase/sale, preferably an on-line sale, of the equipment, and doing so in a manner that minimizes the

activity required by the would-be purchaser of the equipment. For example, the presently claimed embodiment of the invention, provides the purchaser with on-line access to service providers, not just to sellers of industrial equipment, but providers of services independent of the sellers of the industrial equipment, to provide services relating to acquisition, *e.g.*, financing, or to have the equipment transported from a location to another, *e.g.*, to another country involving export and import laws, taxes, tariffs, etc.

The prior art cited does not (1) address the problem to which the present application is directed, or, of course, (2) solve the problem to which the present application is directed. The Conhaim/Thomas-register.com combination relied on by the Examiner merely lists companies that provide products or services. It does not, *e.g.*, coordinate for a potential purchaser of a particular type of industrial equipment, financial services to finance the purchase and/or coordinate transporters/shippers of the particular industrial equipment to and from, *e.g.*, two different countries, etc. The “A” passage cited by the Examiner on pages 4/7 of the Thomas Register merely relates to emailing, not as part of a network, a potential seller of a piece of equipment to request equipment information about the equipment, not service information, via “Fax” while visiting the company’s website. That is not the invention. For example, if one goes to www.thomasregister.com and searches for “condensers,” 111 product headings are located identifying condenser manufacturers. There is no means for the thomasregister.com site to accept input from a purchaser of condensers, *e.g.*, that identifies needed relocation and acquisition services relating to condensers as to which a purchaser wishes to receive information. Certainly, a purchaser can click on a company’s name and get more information about a “condenser,” but not about services, *e.g.*, specifically directed to the financing of a condenser purchase or the relocation, *e.g.*, shipping of a German made condenser from Germany to Austin, TX including *e.g.*, a calculation of freight charges. And there is certainly no means by which the thomasregister.com site transmits information to a potential service provider relating to relocation and/or acquisition services concerning the condenser that are to be rendered. Instead, the thomasregister.com site is merely a listing of companies that provide products and services, not a single network wherein services relating to the purchase and the relocation of industrial equipment exists in a single network wherein industrial equipment acquisition and relocation service providers are contacted in order to facilitate the purchaser’s acquisition/relocation of equipment. Therefore, the combination of

Conhaim with the thomasregister.com site does not teach all of the claimed limitations of the independent Claims 1, 27, 30, 36, 40, 43, 46, 52, 56 and 58 and consequently, Applicants request withdrawal of the rejection.

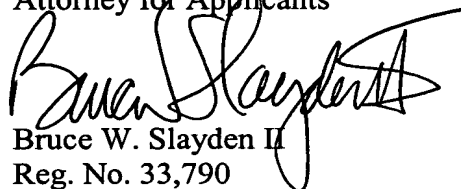
### CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration and allowance of the Claims as presented herein.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants

  
Bruce W. Slayden II  
Reg. No. 33,790

SEND CORRESPONDENCE TO:  
Baker Botts L.L.P.  
CUSTOMER ACCOUNT NO. 31625  
512.322.2606  
512.322.8306 (fax)

Date: 1/11/2005